#23/Response NE
OKOD
3/14/03

Response Under 37 C.F.R. § 1.116
Expedited Procedure, Group Art Unit 2826

03500.013307. PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

6/L to enter OCW 4/9/03

In re Application of:	) :	Examiner: A. Williams
HIDENORI SHIOTSUKA, et al.	) :	Group Art Unit: 2826
Application No.: 09/244,163	) :	
Filed: February 4, 1999	) :	
For: SEMICONDUCTOR DEVICE AND SOLAR CELL MODULE HAVING DETACHABLE CONSTITUENT MEMBERS AND DEGRADABLE RESIN EXFOLIATIVE LAYER	) :	February 20, 2003

BOX AF
Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO FINAL OFFICE ACTION
AND
REQUEST TO WITHDRAW PREMATURE FINAL REJECTION

Sir:

This is in response to the Office Action dated August 20, 2002 (Paper No. 20), the period for response to which having been extended to February 20, 2003 by the accompanying Petition For Extension Of Time, and in connection with which a Notice Of Appeal is being filed concurrently herewith.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addr ssed t : Commissioner of Patents and Trademarks, Washingt n, D.C. 20231
on Feb. 20, 2003
(Date of Deposit)
Dam nd E. Vadnais, Reg no. 52,310
Name of Attorney for Applicant
Domond Vadnais Feb. 20, 2003
Signature Date of Signature

REQUEST TO WITHDRAW PREMATURE FINAL REJECTION

The Office Action was marked "final". It is respectfully submitted that finality of the Office Action was premature, and should be withdrawn, for the following reasons.

Specifically, the prior Amendment (dated May 7, 2002) responded to a rejection entered under § 103(a) over U.S. Patent No. 6,075,202 (Mori). In responding to the rejection, it was specifically pointed out that the independent claims were "amended to include the subject matter of dependent Claims 65 and 69", which depended from independent Claims 1 and 25, respectively. In the present Office Action, a new rejection of Claim 1 was entered over U.S. Patent No. 6,184,577 (Takemura) in view of U.S. Patent No. 4,268,590 (Eranian). In addition, a new rejection of Claims 1 and 25 was entered over Mori in view of Eranian.

Since Claims 1 and 25 were amended to include the substance of their dependent claims, it is clear that it was not Applicants' amendments that necessitated the new grounds of rejection. Rather, it is clear that the Patent Office recognized the deficiencies of the original rejection over Mori, and instituted new rejections not necessitated by Applicants.

Under the circumstances, the finality of the rejections of Claims 1 and 25 is premature, and should be withdrawn.

RESPONSE TO OFFICE ACTION

Claims 1 to 3, 9 to 11, 17, 20, 21, 23 to 27, 33 to 35, 41, 44, 45, 47, 48, 51, 55, 59, 63 and 73 to 80 are in the application, with Claims 9 to 11, 17, 20, 21, 23, 24, 33 to 35, 41, 44, 45, 47, 48, 59, 63 and 77 to 80 having been withdrawn from consideration pursuant to a restriction requirement[1]. Claims 1, 9, 17, 25, 33, 41, 51, 55, 59 and 63 are the independent claims. Reconsideration and further examination are respectfully requested.

Claims 1 to 3, 51 and 73 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,184,577 (Takemura) in view of U.S. Patent No. 4,268,590 (Eranian); Claims 1 to 3, 25 to 27, 51, 55, 73 and 74 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,075,202 (Mori) in view of Eranian; Claim 75 was rejected under 35 U.S.C. § 103(a) over Takemura in view of Eranian, and further in view U.S. Patent No. 6,153,299 (Smith); and Claims 75 and 76 were rejected under 35 U.S.C. § 103(a) over Mori in view of Eranian and further in view of Smith. Reconsideration and withdrawal of the rejections are respectfully requested.

The invention, as recited by Claims 1 and 51, concerns a semiconductor device which includes a substrate, a filler, an exfoliative layer and a semiconductor element. The exfoliative layer comprises an electron ray degradable resin. As set forth in Claim 1, the semiconductor element is detachable from the substrate. As set forth in Claim 51, at least one of the substrate, the filler, and the semiconductor element can be detached from the other constituent members by irradiating the exfoliative layer with electron rays.

[1/] It is believed that the Office Action Summary inadvertently omits Claims 59 and 63 from the list of pending claims, and inadvertently omits Claims 17, 59 and 63 from the list of withdrawn claims. In addition, Claims 25 to 27 should not be included in the list of withdrawn claims.

The invention, as recited by Claims 25 and 55, concerns a solar cell module which includes a substrate, a filler, an exfoliative layer, a photovoltaic element and a protective layer. The exfoliative layer comprises an electron ray degradable resin. As set forth in Claim 25, the photovoltaic element is detachable from the substrate. As set forth in Claim 55, at least one of the substrate, the filler, the photovoltaic element and the protective layer can be detached from the other constituent members by irradiating the exfoliative layer with electron rays.

Thus, according to one feature of the invention, as recited by the claims currently under consideration, the semiconductor device (or solar cell module) has an exfoliative layer which includes an electron ray degradable resin. By virtue of this feature, the detachment of faulty semiconductor device or solar cell module constituents can be facilitated.

The Office Action concedes that Takemura and Mori do not teach or suggest the foregoing feature. Yet, the Office Action asserts that it would have been obvious to modify Takemura and Mori with the teaching of Eranian to include this feature.

However, the motivation to combine Takemura and Mori with Eranian is found only in Applicants' own specification. Viewed in its proper light, the obviousness rejection advanced in the Office Action is an impermissible hindsight rationalization of a result now deemed desirable but nowhere hinted at in the applied art. The prior art must, without the benefit of Applicants' specification, provide a motivation for making the necessary changes in a reference. See MPEP § 2143.01.

In any event, the U.S. Patent to Takemura is not prior art to the subject application. The U.S. filing date of the subject application predates Takemura's patent

grant date and Takemura's § 102(e) date[2]. Accordingly, the Examiner is respectfully requested to remove the U.S. Patent to Takemura as a reference. Takemura does, however, have published counterparts which were published before the U.S. filing date of the subject application, but after the foreign priority date of the subject application.

Mori also is not prior art by virtue of the earlier filing date of Japan 10-24370, which is a Japanese priority application from which the subject application claims priority under 35 U.S.C. § 119. Sworn translations of priority applications Japan 10-24370, filed February 5, 1998 and Japan 11-24968, filed February 2, 1999, were submitted with the Response and Petition For Extension Of Time dated December 12, 2000. In keeping with the procedure under MPEP § 201.15, the Examiner should confirm for himself that Applicants are entitled to their priority date for the claimed subject matter. Once the Examiner is convinced that Applicants are entitled to their priority date, he is respectfully requested to withdraw Mori as a reference against the pending claims.

In light of the above, Applicants respectfully request that the Section 103 rejections be withdrawn.

It is further requested that withdrawn method Claims 9 to 11, 17, 20, 21, 23, 24, 33 to 35, 41, 44, 45, 47, 48, 59, 63 and 77 to 80 be rejoined, under MPEP § 821.04, once the elected product claims have received an indication of allowability.

No other matters being raised, it is believed that the entire application is fully in condition for allowance, and such action is courteously solicited.

[2/]See the cover page of Takemura.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

Attorney for Applicants

Registration No. 52,310

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-2200
Facsimile: (212) 218-2200

CA_MAIN 58989 v 1